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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,813	05/28/2002	Nigel Jeffrie Ricketts	RR-491 PCT/US	3822
7590	01/25/2005			
Rodman & Rodman 7 South Broadway White Plains, NY 10601			EXAMINER ANDREWS, MELVYN J	
			ART UNIT	PAPER NUMBER
			1742	
DATE MAILED: 01/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/031,813	Applicant(s) RICKETTS ET AL.	
	Examiner Melvyn J. Andrews	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9, 11, 12, 33, 34, 39-41, 43-46 and 49-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9, 11, 12, 33 and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>12405</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

The restriction is modified in view of applicants' amendment of July 23, 2004

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 2-9, 11,12, 33 and 52 drawn to a cover gas composition.

Group II, claim(s) 34, 39-41, 43-46, 49-51, 53 and 54 drawn to a method of protecting molten magnesium.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 5 is obvious in view of WO96/22129 which discloses at least C_2F_5H (page 14, line 4) and nitrogen, argon and carbon dioxide (page 12, lines 21 to 25) view of which the claimed cover gas composition is obvious accordingly the special technical features linking the two groups does not provide a contribution over the prior art and no single inventive concept exists.

Claims 34, 39-41, 43-46, 49,50,51, 53 and 54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 12, 2005.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-9, 11,12, 33 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT publication WO 96/22129. The PCT publication discloses compounds suitable for processes for controlling or extinguishing fires (Page 7, lines 21 to last line, page 12, lines 21-23 and page 14, lines 2-7); for example, WO96/22129 discloses compositions containing C_2F_5H (page 14, line 4) and nitrogen, argon and carbon dioxide (page 12 ,line s 21 to 25 in view of which the claimed cover gas composition is obvious , it would have been obvious to one of ordinary skill in the art to select a compound with a low GWP since GWP is a result effective variable *In re Boesch*,205 USPQ 215.

Response to Arguments

Applicant's arguments filed November 12, 2004 have been fully considered but they are not persuasive. Applicants argue that WO 96/22129 relates to a fire extinguishing composition not a cover gas to protect molten magnesium but the limitation "adapted to inhibit the oxidation of the molten magnesium/magnesium alloy" does not further limit the claimed cover gas composition . Applicants have not explained how the components of the claimed cover gas which may contain pentafluoroethane and nitrogen, argon and carbon dioxide differs from the '129 composition.

Claims 2-9, 11,12, 33 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT publication WO 91/02564. The PCT publication discloses fluorinated hydrofluorocarbons such as pentafluoroethane (page 4, lines 1 to 20) it would have been obvious to one of ordinary skill in the art to select a compound with a low GWP since GWP is a result effective variable *In re Boesch*, 205 USPQ 215.

Response to Arguments

Applicant's arguments filed November 12, 2004 have been fully considered but they are not persuasive. Applicants arguments relate to a future use but do not explain how the claimed composition itself, which includes a componet such as, pentafluoroethane is different from the prior art composition containing pentafluoroethane (page 4, line 20) .

Interview

Applicants attorney inquired about status of amendments and arguments filed November 12 , 2005. Examiner indicated that the restriction would be maintained until Claim 5 was allowed. ; the amendment to Claims 5, 34 and 44 "adapted ..." does not clearly limit the claim as intended and it was suggested that the expression "in an effective amount..." be substituted for "adapted" in order to limit the claim see MPEP MPEP 2173.05(c) . Claim 44 includes "consisting" but Claim 45 recites "comprises" this is inconsitent. If Claim 45 were to be examined, a question would be raised under 35 USC 112 1st paragraph since it is unclear that the method would work absent the cover gas. Applicants should explain any differences in the components of claimed cover gas composition with the prior art compositions

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

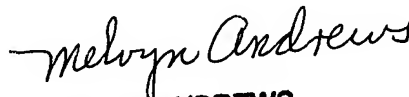
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvyn J. Andrews whose telephone number is (571)272-1239. The examiner can normally be reached on 8:00A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V King can be reached on (571)272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1742

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJA
January 24, 2005


MELVYN ANDREWS
PRIMARY EXAMINER